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EXAMINER

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ART UNIT PAPER NUMBER

3763

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/972,225
Filing Date: October 04, 2001
Appellant(s): DORROS ET AL.

Nicola Pisano
For Appellant

EXAMINER'S ANSWER

MAILED
AUG 11 2004
GROUP 3700

This is in response to the appeal brief filed April 19, 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1-6, 7-9, and 26-29 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

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6,146,370 BARBUT 11-2000

6,022,336 ZADNO-AZIZI ET AL 2-2000

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 5, 7-9, 26, 27, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barbut et al (US 6,555,057) in view of Barbut (US 6,146,370).

Barbut ('057) discloses, (fig. 6D) a system for cerebral blood manipulation including a catheter 12 having a lumen and an occlusive element at the distal end occluding the antegrade flow in a carotid artery, and a flow control device (100 or 104) with a flow control element at the distal end configured for insertion separately from the catheter via subclavian artery and brachiocephalic trunk so that the flow control device inhibits flow to vertebral and common carotid arteries. However, Barbut ('057) fails to disclose the catheter being inserted via the descending aorta.

Barbut ('370) teaches a catheter 1, for cerebral blood manipulation, having a lumen and an occlusive element at the distal end occluding the antegrade flow in a carotid artery that can be introduced through the femoral artery and the descending aorta. Therefore given the teachings, it would have been obvious to one having

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ordinary skill in the art at the time the invention was made to provide Barbut's('057) catheter 12 with a catheter such as that used in Barbut's('370) so that the catheter would be capable of insertion through the descending aorta to manipulate the cerebral blood flow.

3. Claims 3, 4 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barbut('057)in view of Barbut('370), and further in view of Zadno-Azizi et al (US 6,022,336).

Barbut/Barbut discloses the invention substantially as claimed. However, Barbut/Barbut fails to disclose the inflatable having a distal or proximal taper.

Zadno-Azizi teaches a catheter/guidewire having an occlusion balloon (figs. 16-17) with a proximal or distal taper for use in the carotid arteries. This shape allows gradual diameter reduction of the balloon ends in order to minimize trauma to the vessel as well known in the art of balloons. Given the teachings, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Barbut/Barbut's catheters with such tapered balloons as such would merely constitute substitution of functionally equivalent occluding elements.

(11) Response to Argument

Applicant's arguments are narrower than the claims. Barbut '057 discloses the structure of two catheters with an occlusive element, and a flow control device having a flow control element as claimed. Figure 3 shows openings 14,24 in the catheter in fluid communication with the lumen. The secondary reference, Barbut '370, is being used to

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show that a catheter is capable of being inserted in another position and direction, such as in this case through the femoral artery and the descending aorta.

In response to applicant's argument that Barbut '057 fails to disclose the catheter being inserted via the descending aorta, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).


In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

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For the above reasons, it is believed that the rejections should be sustained.

August 6, 2004

Respectfully submitted,



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Art Unit 3763

Conferees

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